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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,321	01/06/2005	Serge Creutz	SN132 PCT 1	9052
137	7590	10/16/2007	EXAMINER	
DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994			PENG, KUO LIANG	
		ART UNIT	PAPER NUMBER	
		1796		
		NOTIFICATION DATE	DELIVERY MODE	
		10/16/2007	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/521,321	CREUTZ ET AL.
	Examiner	Art Unit
	Kuo-Liang Peng	1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 7/23/07 Amendment.
- 2a) This action is **FINAL**.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5,7-11,13,15-17,19 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,7-11,13,15-17,19 and 23-26 is/are rejected.
- 7) Claim(s) 2-5,7-11,13 and 15-17 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. The Applicants' amendment filed July 23, 2007 is acknowledged. Claims 6, 12, 14, 18 and 20-22 are deleted. Claims 1-5, 7-9, 13, 15-16 and 19 are amended. Claims 23-26 are added. Now, Claims 1-5, 7-11, 13, 15-17, 19 and 23-26 are pending.
2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 021707) is/are removed.
3. Claim rejection(s) under 35 USC 102 in paragraph 8 of the previous Office Action (Paper No. 021707) is/are removed.
4. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

### ***Claim Objections***

5. Claims 2-5, 7-11, 13 and 15-17 are objected to because of the following informalities:

In Claims 2-5, 7-11, 13 and 15-17 (line 1), should "A foam control composition" be -- The granulated foam control composition --?

Appropriate correction is required.

***Double Patenting***

6. Claims 1-3, 7-11, 13, 15-17, 19 and 23-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-6, 11-12, 14, 16-18, 20 and 24-25 of copending Application No. 10/521,416. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason: Claims 1-6, 11-12, 14, 16-18, 20 and 24-25 of the copending Application are directed to foam control compositions comprising a polydiorganosiloxane, a hydrophobic filler having a specific particle size, a non-polar polyol ester, which obviously read on the instant claim of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

7. Claims 1, 3, 10-11, 13, 15-17, 19, 23 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Dickinson (GB 1 523 957).

Dickinson discloses a method of manufacturing a **granular** foam control composition comprising a **polydiorganosiloxane** containing radicals such as ethyl, propyl, octyl, tetradecyl, phenyl, benzyl, 2-phenylpropyl, etc., waxes such as polyethylene wax (**a paraffin wax**), **microcrystalline wax**, etc. having specific melting points, a **silica or aluminum oxide** and an emulsifying agent such as **polyoxyethylene distearate**. (page 1, line 21 to page 2, line 28 and Examples) Since the silica is compounded in the presence of the ingredients such as the polysiloxanes, it is inherently surface-modified in-situ. The amount of the wax and emulsifying agent (i.e., additive composition) is described in page 2, lines 52-65. The granulated foam control agent is prepared by utilizing the foam control composition supported on a particulate carrier such as sodium tripolyphosphate, etc. in non-aqueous liquid form. (page 2, lines 29-43 and Examples)

For Applicants' argument (Remarks, page 12, 2<sup>nd</sup> paragraph), Examiner disagrees. First, Dickinson teaches the use of a polydiorganosiloxane in an amount of from 80 to 98 wt% and a silica in an amount of 2 to 20 wt%. (col. 2, lines 7-14) As such, the silica is clearly dispersed in the polydiorganosiloxane. Second, the

hydroxyl groups of aforementioned polyoxyethylene distearate are 100% esterified. Third, the granulated foam control agent is prepared by utilizing the foam control composition supported on a particulate carrier such as sodium tripolyphosphate, etc. in non-aqueous liquid form, *supra*.

***Claim Rejections - 35 USC § 103***

8. Claims 1-5, 7-11, 13, 15-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US 6 610 752) in view of L'Hostis (EP 1 075 863).

The following column and line numbers of L'Hostis is based on its U.S. equivalent, US 6 521 587.

For Claims 1-5, 7-11, 13, 15, 17 and 19, Schmid discloses a method of manufacturing a granular foam control composition comprising a **polydiorganosiloxane** containing methyl, ethyl, propyl, butyl and phenyl groups, a **microfine silanized silica**, a polyol ester such as the esters of glycerol and palmitic acid (typically containing a mixture of **glycerol mono, di-, and tripalmitate**), etc., a **bisamide**, a **fatty acid**, a microcrystalline paraffin wax. (col. 2, line 34 to col. 5, line 56 and Examples) The silica can be silanized and dispersed in the polydiorganosiloxane. (col. 2, line 34 to col. 3, line 18) The granular foam control

composition can be prepared according the method described in col. 3, line 19 to col. 4, line 13, col. 5, line 57 to col. 7, line 67 and Examples. Schmid is silent on the polydiorganosiloxane where the substituents have the claimed mean number of carbon atoms, the claimed long chain alkyl group or the claimed X-Ph moiety.

L'Hostis teaches the use of in a foam control composition a polyorganosiloxane that read on the claimed ones. The motivation of using the specific polyorganosiloxane is to afford a granular foam control composition with **enhanced foam control efficiency**. (col. 2, lines 46-51, col. 2, line 64 to col. 3, line 46, col. 4, line 64 to col. 5, line 28 and col. 7, line 65 to col. 8, line 35) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize L'Hostis' polyorganosiloxane in Schmid's composition with expected success. Especially, L'Hostis is in the same field as that of Schmid's endeavor. Schmid teaches depositing the polydiorganosiloxane, polyol ester, etc. in aqueous liquid form onto the particular carrier. (col. 2, lines 5-30) However, the water is eventually removed. (col. 22, lines 12-25) As such, the prior art's granulated foam control composition is obviously the same as the claimed granulated foam control composition where the polydiorganosiloxane, polyol ester, etc. is used in non-aqueous form.

For Claim 16, Schmid is silent on the **microfine** silanized silica having the claimed average particle size. However, L'Hostis teaches that it is well known to use hydrophobic fillers such as silica with particle size of 0.5 to 50 **microns** for foam control agents. The silica is well known and is **commercially available**. (col. 6, line 60 to col. 7, line 28) As such, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize L'Hostis' silica filler in Schmid's composition because Schmid's silica is **microfine** and the commercial availability of L'Hostis' silica. Especially, L'Hostis is in the same field as that of Schmid's endeavor, and Applicants do not show the **criticality** of the particle size.

For Applicants' argument (Remarks, page 13, 2<sup>nd</sup> paragraph to page 14, 3<sup>rd</sup> paragraph), Applicants' argument is not persuasive for the reason set forth above.

9. Claims 2 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson in view of Schmid.

Dickinson discloses a method of manufacturing a **granular foam control composition**, *supra*, which is incorporated herein by reference. The composition can contain a **water-insoluble wax**, such as polyethylene wax (a **paraffin wax**), etc. (page 2, lines 18-20) Dickinson is silent on the specific use of a glycerol triester. However, Schmid teaches a method of manufacturing a **granular foam**

**control composition utilizing an water-insoluble wax, such as paraffin wax, glycerol triester, etc.** (col. 4, line 14 to col. 5, line 56) As such, Schmid does teach the equivalency between paraffin wax and glycerol triester for preparing a granular foam control composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the glycerol triester in Dickinson's composition with expected success. Especially, Schmid is in the same field as that of Dickinson's endeavor.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
October 10, 2007

  
Kuo-Liang Peng  
Primary Examiner  
Art Unit 1796